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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,925	03/30/2001	Bradford H. Needham	PW 027 5024 P-10877	8278
7590 12/01/2004			EXAMINER	
Crystal D Sayles Blakely Sokoloff Taylor & Zafman LLP 12400 Wilshire Boulevard Seventh Floor Los Angeles, CA 90025			AGGARWAL, YOGESH K.	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,925

Applicant(s)

NEEDHAM, BRADFORD H.

Examiner

Yogesh K Aggarwal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers (US PG-PUB # 2002/0101519) in view of Suzuki et al. (US PG-PUB # 2002/0072922).

[Claim 1]

Myers teaches a system for automatically annotating a digital representation (Paragraph 41, figure 4), comprising an electronic capture device (figure 1, element 2) to capture the digital representation of a scene (Paragraph 19), an information tag device (figure 1, element 1a or 25a) to store identification data for identifying the scene (Paragraph 19), a tag-reader (figure 1, element 3) to receive the identification data from the information tag device (Paragraph 18), a database (figure 1, element 8) to store information for the information tag device (Paragraph 25), a communication device (figure 1, element 5) to communicate with the database (Paragraph 25). It is inherent that a communication device (5) like a PC has a program to be executed to control communication of the identification data with the database. Myers teaches that captions can be transmitted to the database 8 and can be used as metadata for annotating the image (See figure 4, a box on the left in the third row from the top indicates 'captions', Paragraph 43) but does not teach information for an annotation or caption provider is transmitted from the database to the communication device. However Suzuki et al. teaches that URLs stored in the servers 15 through 17 used to access a resource like a caption provider linked to the URL (Paragraph 120, figure 6)

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can be transmitted via internet from the server databases 15-17 to the client 10 or 11 as shown in figure 3. Therefore taking the combined teachings of Myers and Suzuki, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have an annotation or a caption provider URL be stored in a server and transmitted to the client as taught in Suzuki and embed as metadata to be annotated on the image as taught in Myers in order to annotate the image data with a caption. The benefit of doing so would be so that a server having large memory capacity and stores large number of URLs giving the user more choice in selecting the captions from different caption providers.

[Claim 2]

Myers teaches that the communication device is a computer (Paragraph 25, figure 1, element 5)

[Claim 3]

Myers teach wherein the communication device is part of the electronic capture device (Paragraph 23, figure 1, element 4).

[Claim 4]

Myers teaches wherein the communication device further includes a processing device, the processing device being utilized to associate the captured digital representation with a particular identification tag device (Paragraph 22, figure 3, element 14)

[Claim 5]

Myers teaches wherein the electronic capture device is a camera (figure 1).

[Claim 6]

Myers teaches wherein the tag-reader is located within the electronic capture device (Paragraph 19, figure 1, element 3).

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[Claims 7 and 9]

Suzuki teaches that the information stored in the database is a URL for the caption (Paragraph 120, figure 6) and Myers teach that these captions are used to annotate a scene as metadata (Paragraph 41).

[Claim 8]

It would be inherently taught that when the URL for the caption is received by the communication device (client) as taught in Suzuki, the program in that communication device can be used to contact the caption provider via the URL supplied and at least one option for providing a caption can be provided to a user.

[Claims 10-16]

These are method claims corresponding to apparatus claims 1, 3-5, 7-9 respectively. Therefore they have been analyzed and rejected based upon apparatus claims 1, 3-5, 7-9.

[Claim 17]

Myers teaches a system for automatically annotating a digital representation (Paragraph 41, figure 4), comprising an electronic capture device (figure 1, element 2) to capture the digital representation of a scene (Paragraph 19), an information tag device (figure 1, element 1a or 25a) to store identification data for identifying the scene (Paragraph 19), a tag-reader (figure 1, element 3) to retrieve the identification data from the information tag device (Paragraph 18), wherein the identification tag is utilized to store information for the information tag device (Paragraph 25), a communication device (figure 1, element 5) to communicate with the database (figure 1, element 8) to store information for the information tag device (Paragraph 25) (Paragraph 25, figure 1, element 8). Myers teaches that captions can be transmitted to the

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database 8 and can be used as metadata for annotating the image (See figure 4, a box on the left in the third row from the top indicates 'caption', paragraph 43) but does not teach information for an annotation or caption provider is transmitted from the database to the communication device. However Suzuki et al. teaches that URLs stored in the servers 15 through 17 used to access a resource like a caption provider linked to the URL (Paragraph 120, figure 6) can be transmitted via internet from the server databases 15-17 to the client 10 or 11 as shown in figure 3. Therefore taking the combined teachings of Myers and Suzuki, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have an annotation or a caption provider URL be stored in a server and transmitted to the client as taught in Suzuki and embed as metadata to be annotated on the image as taught in Myers in order to annotate the image data with a caption. The benefit of doing so would be so that a server having large memory capacity and stores large number of URLs giving the user more choice in selecting the captions from different caption providers.

[Claims 18-23, 24]

See claims 3-7, 9, and 8.

[Claim 24]

It would be inherently taught that a communication device (5) like a PC has a program to be executed to control communication of the identification data with the database.

[Claim 27]

Myers teaches that captions can be transmitted to the database 8 and can be used as metadata for annotating the image (See figure 4, a box on the left in the third row from the top indicates 'captions', Paragraph 43) but does not teach information for an annotation or caption provider is

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transmitted from the database to the communication device. However Suzuki et al. teaches that URLs stored in the servers 15 through 17 used to access a resource like a caption provider linked to the URL (Paragraph 120, figure 6) can be transmitted via internet from the server databases 15-17 to the client 10 or 11 as shown in figure 3. Therefore taking the combined teachings of Myers and Suzuki, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have an annotation or a caption provider URL be stored in a server and transmitted to the client as taught in Suzuki and embed as metadata to be annotated on the image as taught in Myers in order to annotate the image data with a caption. The benefit of doing so would be so that a server having large memory capacity and stores large number of URLs giving the user more choice in selecting the captions from different caption providers.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 26, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Myers (US PG-PUB # 2002/0101519).

[Claim 26]

Myers teaches a camera for automatically annotating digital images (Paragraph 41, figure 4), comprising an electronic capture device (figure 1, element 2) to capture the digital representation of a scene (Paragraph 19), a tag-reader (figure 1, element 3) to receive the identification data

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from an information tag device (Paragraph 18), a memory (figure 3, element 13) to store the digital representation and the identification data associated therewith (See figure 2, step S205), an I/O to transfer data between the memory and a communication device (figure 2, step S206), wherein the communication device transfers the data with a database (step S207), wherein information for the information tag device is stored in the database (Paragraphs 37-40).

[Claim 28]

See Claim 24.

[Claim 29]

See claim 3.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- i. Weston et al. (US Patent # 6608563)
- ii. Morris (US PG-PUB # 20020088000)
- iii. Squilla et al. (6623528)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh K Aggarwal whose telephone number is (703) 305-0346. The examiner can normally be reached on M-F 9:00AM-5:30PM.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YKA

November 17, 2004


TUAN HO
PRIMARY EXAMINER